

ESTTA Tracking number: **ESTTA610779**

Filing date: **06/18/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92056552
Party	Plaintiff ActiMuse, LLC
Correspondence Address	DANIEL J CHALKER CHALKER FLORES LLP 14951 N DALLAS PARKWAY, SUITE 400 DALLAS, TX 75254 UNITED STATES ecortez@chalkerflores.com, dchalker@chalkerflores.com, jflores@chalkerflores.com, docket@chalkerflores.com, cminchillo@chalkerflores.com
Submission	Response to Board Order/Inquiry
Filer's Name	Daniel J. Chalker
Filer's e-mail	dchalk- er@chalkerflores.com,cminchillo@chalkerflores.com,docket@chalkerflores.com
Signature	/Daniel J. Chalker/
Date	06/18/2014
Attachments	Pet's Resp to Board Order 061814.pdf(121586 bytes) Exhibit A to Pet's Resp 061814.pdf(841386 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

ACTIMUSE, LLC,

Petitioner,

v.

ADDICTION NV, LLC

Registrant/Respondent.

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Cancellation No. 92056552

U.S. Registration No. 4,089,155
Mark: ADDICTION NV
COSMETICS

PETITIONER'S RESPONSE TO BOARD'S ORDER

Petitioner, Actimuse, LLC, by and through its undersigned counsel hereby submits its response to the Board's Order of May 19, 2014.

I. THE BOARD'S ORDER OF MAY 19, 2014

The Board's Order of May 19, 2014 allowed Petitioner thirty days to show cause why the Board should not treat the failure to file a brief as a concession of the case. (Order at 1). Petitioner submits that the parties settlement activities and actions pursuant thereto, and Registrant's abandoned their registered mark ADDICTION NV COSMETICS, are sufficient to show cause why the Board should not treat the failure to file a brief as a concession of the case.

II. THE PARTIES AGREED TO SETTLEMENT TERMS

Petitioner and Registrant agreed to terms to settle the above-reference cancellation and the dispute between the parties. The parties agreed in principle to the following settlement terms:

1. Registrant will cancel its registration for ADDICTION NV COSMETICS;

2. Registrant will expressly abandon its trademark applications for ADDICTION COSMETICS (design mark) and ADDICTION COSMETICS (word mark);
3. Petitioner will grant Registrant and its owners, as individuals, a one year phase out period to sell its remaining inventory; and
4. Petitioner will dismiss the cancellation proceeding.

(Exhibit A at 2).

Although, a settlement agreement was not executed, the parties have taken actions consistent with the settlement terms:

1. Registrant has stopped selling cosmetics and commercial use of its website (Exhibits A at 2 and A-1);
2. Registrant's status with the California Secretary of State is "CANCELED" (Exhibits A at 2 and A-2);
3. Registrant did not respond to outstanding Office Actions in its trademark applications for the design mark ADDICTION COSMETICS (77/945,497) and word mark ADDICTION COSMETICS (77/945,447) (Exhibits A at 2-3, A-3, A-4, A-5 and A-6); and
4. Petitioner did not prevent Registrant from selling its remaining inventory (Exhibit A at 2).

Additional filings were not submitted to the Board because the settlement terms had been reached, but a settlement agreement had not been executed.

Petitioner submits that the parties settlement activities and actions pursuant thereto as described above are sufficient to show cause why the Board should not treat the failure to file a brief as a concession of the case.

III. REGISTRANT HAS ABANDONED USE OF THEIR REGISTERED MARK

Part one of 15 U.S.C. §1127 provides “A mark shall be deemed to be ‘abandoned’ if ... the following occurs: (1) When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment. ‘Use’ of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.”

Registrant has discontinued use of their registered mark ADDICTION NV COSMETICS with intent not to resume such use because:

- (1) Registrant’s webpage at www.addictionnv.com states “ADDICTION NV cosmetics are no longer available” (Exhibits A at 2 and A-1);
- (2) The legal status of Registrant is listed as “CANCELED” by the California Secretary of State (Exhibits A at 2 and A-2);
- (3) Registrant’s trademark application 77/945,497 for the design mark ADDICTION COSMETICS was abandoned on February 13, 2014 for failing to respond to an Office Action (Exhibits A at 2, A-3 and A-4); and
- (4) Registrant did not respond to an Office Action in trademark application 77/945,447 for the mark ADDICTION COSMETICS. The application proceeded to publication because the Examining Attorney entered an Examiner’s Amendment when a response to the Office Action was not received (Exhibits A at 2-3, A-5 and A-6).

Accordingly, Registrant has abandoned its registered mark ADDICTION NV COSMETICS.

Petitioner submits that Registrant's abandonment of its registered mark ADDICTION NV COSMETICS is sufficient to show cause why the Board should not treat the failure to file a brief as a concession of the case.

IV. CONCLUSION

For all the reasons stated above, Petitioner prays that the Board either enter: (1) an order finding that Registrant has abandoned its registered mark and canceling U.S. Registration No. 4,089,155; or (2) grant the parties sixty (60) days to execute a settlement agreement and/or file documents with the Board disposing of the issues in this proceeding. Petitioner also prays that the Board grants all other and further relief to which Petitioner is justly entitled.

Dated: June 18, 2014

Respectfully submitted,


CHALKER FLORES, LLP

By: 

Daniel J. Chalker
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14951 N. Dallas Parkway, Suite 400
Dallas, Texas 75254
(214) 866-0001 (telephone)
(214) 866-0010 (telecopy)
dchalker@chalkerflores.com
ATTORNEY FOR PETITIONER

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing PETITIONER'S RESPONSE TO BOARD'S ORDER was served on all counsel of record, this the 18th of June, 2014, by sending the same via electronically through the Electronic System for Trademark Trials and Appeal ("ESTTA") and electronic mail service.


Daniel J. Chalker

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

ACTIMUSE, LLC,

Petitioner,

v.

ADDICTION NV, LLC

Registrant/Respondent.

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Cancellation No. 92056552

U.S. Registration No. 4,089,155
Mark: ADDICTION NV
COSMETICS

**EXHIBIT A
AFFIDAVIT OF DANIEL J. CHALKER
IN SUPPORT OF PETITIONER'S RESPONSE TO BOARD'S ORDER**

STATE OF TEXAS

§
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COUNTY OF DALLAS

BEFORE ME, the undersigned notary public, on this day personally appeared DANIEL J. CHALKER, known to me to be the person whose name is subscribed below, and upon his oath, deposed and stated as follows:

“My name is Daniel J. Chalker. I am over the age of twenty-one (21) years, am of sound mind, and have never been convicted of a crime or offense involving moral turpitude. I am fully authorized and competent to execute this Affidavit and am not disqualified by law from making this Affidavit. All facts stated herein are within my personal knowledge, and under penalty of perjury, I declare they are true and correct.

“I am a founding partner of Chalker Flores, LLP and lead attorney representing

Petitioner, Actimuse, LLC, in the above-referenced cancellation proceeding.

“The parties agreed in principle to the following settlement terms:

1. Registrant will cancel its registration for ADDICTION NV COSMETICS;
2. Registrant will expressly abandon its trademark applications for ADDICTION COSMETICS (design mark) and ADDICTION COSMETICS (word mark);
3. Petitioner will grant Registrant and its owners, as individuals, a one year phase out period to sell its remaining inventory; and
4. Petitioner will dismiss the cancellation proceeding.

“A settlement agreed was not executed.

“Petitioner has not prevented Registrant from selling its remaining inventory.

“Exhibit A-1, attached hereto, is a true and accurate print out of the Registrant’s webpage www.addictionnv.com taken on June 18, 2014 states ‘ADDICTION NV cosmetics are no longer available.’

“Exhibit A-2, attached hereto, is a true and accurate print out from the California Secretary of State website taken on June 18, 2014 showing that the legal status of Registrant, Addiction NV Cosmetics, LLC is ‘CANCELED’.

“Exhibits A-3 and A-4, attached hereto, are of true and accurate print outs from the USPTO TESS database showing that Registrant’s trademark application 77/945,497 for the design mark ADDICTION COSMETICS was abandoned on February 13, 2014 for failing to respond to an Office Action.

“Exhibits A-5 and A-6, attached hereto, are of true and accurate print outs from the USPTO TESS database showing that Registrant did not respond to an Office Action in trademark application 77/945,447 for the mark ADDICTION COSMETICS. The application proceeded to

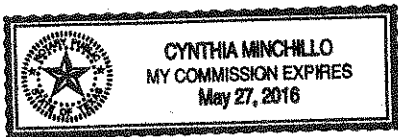
publication because the Examining Attorney entered and Examiner's Amendment when a response to the Office Action was not received.

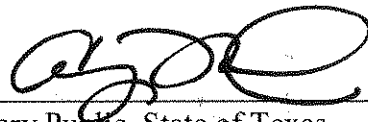
"On information and belief based Exhibit's A-1 through A-6, Registrant has ceased business under the name ADDICTION COSMETICS, and has abandoned use of the marks ADDICTION COSMETICS and ADDICTION NV COSMETICS with intent not to resume, except to inform the public that its products are no longer available.

"Affiant says nothing further."


Daniel J. Chalker

SUBSCRIBED AND SWORN TO BEFORE ME BY Daniel J. Chalker on the 18th day of June, 2014, to certify which witness my hand and seal of office.




Notary Public, State of Texas

ADDICTION·NV
cosmetics

are no longer available.

For more inquiries and questions, please email
roelsweeny@gmail.com or call (949)439-5762.

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Business Entity Detail

Data is updated to the California Business Search on Wednesday and Saturday mornings. Results reflect work processed through Tuesday, June 17, 2014. Please refer to [Processing Times](#) for the received dates of filings currently being processed. The data provided is not a complete or certified record of an entity.

Entity Name:	ADDICTION NV COSMETICS, LLC
Entity Number:	200921710185
Date Filed:	08/04/2009
Status:	CANCELED
Jurisdiction:	CALIFORNIA
Entity Address:	17530 VONKARMAN AVE
Entity City, State, Zip:	IRVINE CA 92614
Agent for Service of Process:	SCOTT SIMON
Agent Address:	17530 VONKARMAN AVE
Agent City, State, Zip:	IRVINE CA 92614

* Indicates the information is not contained in the California Secretary of State's database.

* **Note:** If the agent for service of process is a corporation, the address of the agent may be requested by ordering a status report.

- For information on checking or reserving a name, refer to [Name Availability](#).
- For information on ordering certificates, copies of documents and/or status reports or to request a more extensive search, refer to [Information Requests](#).
- For help with searching an entity name, refer to [Search Tips](#).
- For descriptions of the various fields and status types, refer to [Field Descriptions and Status Definitions](#).

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Word Mark	ADDICTION COSMETICS
Goods and Services	(ABANDONED) IC 003. US 001 004 006 050 051 052. G & S: Cosmetics
Mark Drawing Code	(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
Design Search Code	26.11.13 - Rectangles (exactly two rectangles); Two rectangles 26.11.16 - Rectangles touching or intersecting 26.11.21 - Rectangles that are completely or partially shaded
Serial Number	77945497
Filing Date	February 25, 2010
Current Basis	1B
Original Filing Basis	1B
Owner	(APPLICANT) ADDICTION NV , LLC AKA ADDICTION COSMETICS LIMITED LIABILITY COMPANY CALIFORNIA 17530 VON KARMAN AVE. IRVINE CALIFORNIA 92614
Attorney of Record	Nelson A. Quintero
Disclaimer	NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "COSMETICS" APART FROM THE MARK AS SHOWN

Description of Mark The color(s) black, white, and pink is/are claimed as a feature of the mark. The mark consists of the literal element ADDICTION COSMETICS superimposed respectively on two solid bars and in a stylized white font, so appearing to have been produced on a label maker, wherein the bar for ADDICTION is black, and the bar for COSMETIC is pink, and the bar for COSMETICS is skewed and partially overlapping that for ADDICTION.

Type of Mark TRADEMARK

Register PRINCIPAL

Live/Dead Indicator DEAD

Abandonment Date February 13, 2014

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Side - 1



NOTICE OF ABANDONMENT
MAILING DATE: Mar 12, 2014

The trademark application identified below was abandoned in full because a response to the Office Action mailed on Aug 12, 2013 was not received within the 6-month response period.

If the delay in filing a response was unintentional, you may file a petition to revive the application with a fee. If the abandonment of this application was due to USPTO error, you may file a request for reinstatement. Please note that a petition to revive or request for reinstatement **must be received within two months from the mailing date of this notice.**

For additional information, go to <http://www.uspto.gov/teas/petinfo.htm>. If you are unable to get the information you need from the website, call the Trademark Assistance Center at 1-800-786-9199.

SERIAL NUMBER: 77945497
MARK: ADDICTION COSMETICS
OWNER: ADDICTION NV, LLC

Side - 2

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Nelson A. Quintero
Quintero Law Office, PC
615 Hampton Drive, Suite A202
Venice, CA 90291

EXH. A-4



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ADDICTION COSMETICS

Word Mark	ADDICTION COSMETICS
Goods and Services	IC 014. US 002 027 028 050. G & S: Jewelry
	IC 025. US 022 039. G & S: Coats; Dresses; Footwear; Gloves; Headwear; Hosiery; Jackets; Lingerie; Pants; Raincoats; Scarves; Shirts; Skirts; Sleepwear; Tank tops; Undergarments
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	77945447
Filing Date	February 25, 2010
Current Basis	1B
Original Filing Basis	1B
Published for Opposition	April 29, 2014
Owner	(APPLICANT) Addiction NV , LLC AKA Addiction Cosmetics LIMITED LIABILITY COMPANY CALIFORNIA 17530 Von Karman Ave. Irvine CALIFORNIA 92614
Attorney of	Nelson A. Quintero

Record

Type of Mark TRADEMARK
Register PRINCIPAL
Live/Dead Indicator LIVE

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To: Addiction NV, LLC (naquintero@quinterolaw.com)
Subject: U.S. TRADEMARK APPLICATION NO. 77945447 - ADDICTION COSMETICS - 2382997T
Sent: 3/14/2014 12:45:07 PM
Sent As: ECOM118@USPTO.GOV
Attachments:

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

U.S. APPLICATION SERIAL NO. 77945447

MARK: ADDICTION COSMETICS

77945447

CORRESPONDENT ADDRESS:

Nelson A. Quintero
Quintero Law Office, PC
615 Hampton Drive, Suite A202
Venice CA 90291

GENERAL TRADEMARK INFORMATION
<http://www.uspto.gov/trademark>

APPLICANT: Addiction NV, LLC

CORRESPONDENT'S REFERENCE/DOCKET NO. :

2382997T

CORRESPONDENT E-MAIL ADDRESS:

naquintero@quinterolaw.com

EXAMINER'S AMENDMENT

ISSUE/MAILING DATE: 3/14/2014

APPLICATION HAS BEEN AMENDED: In accordance with the policy and procedures announced in 37 C.F.R. section 2.65(a), the Office has entered the amendment noted below in the referenced application. The applicant did not respond to the Office action dated August 12, 2013. The identification of goods is amended so that the application may proceed.

No response is necessary. TMEP §707. Any amendments to the identification of goods and/or services may clarify or limit the goods and/or services, but may not add to or broaden the scope of the goods and/or services. 37 C.F.R. §2.71(a); *see* TMEP §§1402.06 *et seq.*

Deletion of Classes 3 and 21

The application is amended to delete Classes 3 and 21 from the application.

Deletion of Disclaimer

The disclaimer is deleted.

/Leigh Caroline Case/
Trademark Attorney
(571) 272-9140
leigh.case@uspto.gov (preferred)

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the Trademark Electronic Application System (TEAS) form at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.

To: Addiction NV, LLC (naquintero@quinterolaw.com)
Subject: U.S. TRADEMARK APPLICATION NO. 77945447 - ADDICTION COSMETICS - 2382997T
Sent: 3/14/2014 12:45:09 PM
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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

**IMPORTANT NOTICE REGARDING YOUR
U.S. TRADEMARK APPLICATION**

USPTO OFFICE ACTION (OFFICIAL LETTER) HAS ISSUED
ON **3/14/2014** FOR U.S. APPLICATION SERIAL NO. 77945447

Please follow the instructions below:

(1) TO READ THE LETTER: Click on this [link](#) or go to <http://tsdr.uspto.gov/>, enter the U.S. application serial number, and click on "Documents."

The Office action may not be immediately viewable, to allow for necessary system updates of the application, but will be available within 24 hours of this e-mail notification.

(2) QUESTIONS: For questions about the contents of the Office action itself, please contact the assigned trademark examining attorney. For *technical* assistance in accessing or viewing the Office action in the Trademark Status and Document Retrieval (TSDR) system, please e-mail TSDR@uspto.gov.

WARNING

PRIVATE COMPANY SOLICITATIONS REGARDING YOUR APPLICATION: Private companies **not** associated with the USPTO are using information provided in trademark applications to mail or e-mail trademark-related solicitations. These companies often use names that closely resemble the USPTO and their solicitations may look like an official government document. Many solicitations require that you pay "fees."

Please carefully review all correspondence you receive regarding this application to make sure that you are responding to an official document from the USPTO rather than a private company solicitation. All official USPTO correspondence will be mailed only from the "United States Patent and Trademark Office" in Alexandria, VA; or sent by e-mail from the domain "@uspto.gov." For more information on how to handle private company solicitations, see

http://www.uspto.gov/trademarks/solicitation_warnings.jsp.